

REMARKS

This paper is filed in response to the official action dated August 12, 2005 (hereafter, the "official action"). This paper is timely-filed as it is accompanied by a petition for an extension of time to file in the first month and a check covering the requisite one-month extension fee of \$120.

Claims 1-17 are pending in this application. By the foregoing amendments, claims 1-4 and 10 have been amended and claims 12-17 have been canceled without prejudice or disclaimer. Support for the amendment to claim 1 may be found, for example, at the second full paragraph on page 6 of the present application. The other amendments were made to correct typographical errors. No new matter has been added. Claims 1-11 remain at issue.

Claims 1-11 have been rejected under 35 U.S.C. §112, second paragraph as indefinite. Claims 1, 2, 5, 7, and 8 have been rejected under 35 U.S.C. §102(e) as anticipated by or, in the alternative, under 35 U.S.C. §103(a) as obvious over U.S. Patent No. 6,716,566 to Aoshima ("Aoshima"). Claims 4 and 6 have been rejected under 35 U.S.C. §103(a) as obvious over Aoshima in view of U.S. Patent Publication No. US 2004/0219454 to Foster *et al.* ("Foster"). Finally, claims 4 and 6 have been rejected under 35 U.S.C. §103(a) as obvious over Aoshima in view of U.S. Patent No. 6,835,532 to Jung ("Jung").

The various bases for the claim rejections are addressed below in the order presented in the official action. Reconsideration of the application, as amended and in view of the following remarks, is solicited.

CLAIM REJECTIONS – 35 U.S.C. §112

Claims 1-11 have been rejected under 35 U.S.C. §112, second paragraph, as indefinite.

Claims 1-4 have been amended to correct the asserted indefiniteness problem in claims 1-11. It is respectfully submitted that the asserted indefiniteness problem did not render claims 1-11 indefinite under §112, because a claim is considered definite as long as "the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent." *See M.P.E.P. § 2173.* Nevertheless, in view of the amendment to claims 1-4 presented herein, the rejections of claims 1-11 for indefiniteness should be withdrawn.

CLAIM REJECTIONS – 35 U.S.C. §102

Claims 1, 2, 5, 7, and 8 have been rejected under 35 U.S.C. §102(e) as anticipated by Aoshima. The applicants respectfully traverse the rejections.

It is well-established that each and every limitation of a claimed invention must be present in a single prior art reference in order for anticipation to occur. *See*, for example, C.R. Bard, Inc. v. M3 Systems, Inc., 157 F.3d 1340, 1349 (Fed. Cir. 1998). The standard for anticipation is one of strict identity.

Aoshima discloses a negative planographic printing plate, which is obtained by applying a photosensitive layer application solution containing an infrared absorber, a compound which generates a radical or acid due to heat, a polymerizable compound or a crosslinking compound, and a silicon-based surfactant onto a substrate and drying the solution. *See* Aoshima abstract. Aoshima generally teaches that any silicon-based surfactant having a siloxane skeleton may be used, but that silicon-based surfactants comprising siloxane/oxyethylene copolymers are preferred. *See* Aoshima at column 3, lines 2-23.

The polydimethylsiloxane polymer recited in claims 1-11 is neither a surfactant nor a copolymer containing oxyethylene units. Moreover, Aoshima does not teach or suggest a polydimethylsiloxane polymer having a weight average molecular weight between about 14,000 grams per mol (g/mol) and about 21,000 g/mol, as recited in claim 1.

Thus, the applicants respectfully submit that the anticipation rejections of claims 1, 2, 5, 7 and 8 over Aoshima should be withdrawn.

CLAIM REJECTIONS – 35 U.S.C. §103

Claims 1, 2, 5, 7, and 8 have been rejected (in the alternative) under 35 U.S.C. §103(a) as obvious over Aoshima. Claims 4 and 6 have been rejected under 35 U.S.C. §103(a) as obvious over Aoshima in view of Foster. Finally, claims 4 and 6 have been rejected under 35 U.S.C. §103(a) as obvious over Aoshima in view of Jung. The applicants respectfully traverse the rejections.

A *prima facie* case of obviousness must satisfy three legal requirements. First, there must be some suggestion or motivation, either in the references themselves, or in knowledge generally available to one of ordinary skill in the art, to modify the

reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Third, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. *See M.P.E.P. §2143.* These criteria have not been satisfied with respect to claim 1, as amended herein.

CLAIMS 1, 2, 5, 7, AND 8 -- AOSHIMA

As previously discussed above, Aoshima discloses a photosensitive layer application solution containing an infrared absorber, a compound which generates a radical or acid due to heat, a polymerizable compound or a crosslinking compound, and a silicon-based *surfactant* onto a substrate and drying the solution. The polydimethylsiloxane polymer recited in claims 1-11 is neither a surfactant nor a copolymer containing oxyethylene units. Moreover, Aoshima does not teach or suggest a polydimethylsiloxane polymer having a structure in accordance with formula 1 and a weight average molecular weight between about 14,000 grams per mol (g/mol) and about 21,000 g/mol, as recited in claim 1.

In view of the foregoing, the applicants submit that a *prima facie* case of obviousness has not been established, and that the rejections of claims 1, 2, 5, 7, and 8 as obvious over Aoshima should be withdrawn.

CLAIMS 4 AND 6 -- AOSHIMA IN VIEW OF FOSTER

The deficiencies of Aoshima have been addressed above. Foster does not remedy any of these deficiencies. For example, Foster does not disclose or suggest a polydimethylsiloxane polymer having a structure in accordance with formula 1 and a weight average molecular weight between about 14,000 grams per mol (g/mol) and about 21,000 g/mol, as recited in claim 1.

Thus, the applicants submit that Foster, alone or in combination with Aoshima, does not disclose or suggest the organic anti-reflective coating compositions recited by pending claims 4 and 6. Accordingly, the rejection of claims 4 and 6 as being obvious over Aoshima in view of Foster should be withdrawn.

CLAIMS 4 AND 6 -- AOSHIMA IN VIEW OF JUNG

Aoshima was applied against the claims under 35 U.S.C. §102(e). *See* official action at pages 2 and 3. References that qualify as prior art only under one or more of

35 U.S.C. §§102(e), (f), and (g) may not be applied against pending claims in an obviousness rejection when the requisite common ownership is established.

Statement Concerning Common Ownership

The present application and Jung (i.e., U.S. Patent No. 6,835,532) were, at the time the presently claimed invention was made, commonly owned by, or subject to an obligation of assignment to Hynix Semiconductor Inc.

In view of the common ownership of the presently claimed invention and Jung, *at the time the later invention was made*, the rejections of claims 4 and 6 as obvious over Aoshima in view of Jung should be withdrawn. See 35 U.S.C. 103(c).

CONCLUSION

It is submitted that the application is in condition for allowance. Should the examiner wish to discuss any matter of form or procedure in an effort to advance this application to allowance, he is respectfully invited to telephone the undersigned attorney at the indicated telephone number.

Respectfully submitted,

MARSHALL, GERSTEIN & BORUN LLP

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Andrew M. Lawrence

Andrew M. Lawrence, Reg. No. 46,130
Attorney for Applicants
6300 Sears Tower
233 S. Wacker Drive
Chicago, Illinois 60606-6357
(312) 474-6300